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TOWNSEND and TOWNSEND and CREW LLP

By: *Cindy Bennett*
Cindy Bennett

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GROUP 3600

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS

In re application of:

Stephen Chin

Application No.: 09/307,485

Filed: May 10, 1999

For: INTERNET-BASED MONEY
ORDER SYSTEM

Examiner: Pwu, Jeffrey C.

Art Unit: 3624

APPELLANT'S BRIEF UNDER
37 CFR §1.192

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Appellant offers this brief in furtherance of the Notice of Appeal mailed on June 7, 2002 in the above-referenced case. This brief is submitted in triplicate as required by 37 CFR 1.192(a)

REAL PARTY IN INTEREST:

First Data Corporation and BidPay.com, Inc. are the real parties in interest for this appeal.

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RELATED APPEALS AND INTERFERENCES:

No other appeals or interferences are known which will directly affect, are directly affected by, or have a bearing on the board decision of the pending appeal.

STATUS OF CLAIMS:

Claims 1-26 are currently pending in the application, but stand rejected by the Examiner. Claims 1-10 are as originally filed in the application on May 10, 1999. Claims 11-25 were added in the response to the first Office Action filed on September 28, 2001. Claim 26 was added in response to the final Office Action that was filed April 5, 2002. No Claims have been canceled or amended.

Claims 1-26 are believed improperly rejected and are the subject of this appeal. A copy of the claims as rejected is attached as Appendix A.

STATUS OF AMENDMENTS:

Claim 26 was added in an after final amendment on April 5, 2002 and was entered in the Advisory Action mailed May 13, 2002.

SUMMARY OF THE INVENTION:

In one embodiment, the claimed invention relates to purchasing a money order via the internet 12. See Application, Fig. 1. A money order system 100 can generate the money

orders. A user or buyer 14 can contact the money order system 100 through the internet 12 when desiring to purchase a money order in a predefined amount. See Id., page 5, second full paragraph. Information required to purchase the money order is transmitted to the money order system 100 via the internet 12. See Id., page 5, last paragraph. In this embodiment, the information includes at least a user identification, a receiver identification and an amount of the money order. Id. The money order is generated from the money order system 100 upon receipt of the information. The generated money order is sent to the intended receiver or buyer 14. See Id., page 6, lines 21-26.

Another embodiment uses the money order features for a purchase in an internet auction. See Id., page 3, lines 11-16. The bid is awarded to the buyer via the auction site 10 or some other financial transaction is negotiated between buyer and seller. See Id., Fig. 3, step 200. After the award, the buyer 14 contacts another web site 100 for the money order. Information on the purchase is passed to that other web site 100. See Id., Fig. 3, step 208. The money order is generated and delivered to the seller 14. See Id., Fig. 3, steps 216 and 218. The seller 14 delivers the goods to the buyer 14.

Other embodiments and embellishments are possible for the invention. For example, the buyer or seller could be sent a message after the money order is sent, authorized and/or fulfilled. See Id., page 4, lines 20-28 and Fig. 3, step 220. Some embodiments create a stored value account in the money order system 100. See Id., page 6, lines 5-12. Payments for money orders can be deducted from this account. Other embodiments could ship the goods after the money order is sent, but before it is received. See Id., page 4, lines 23-28.

ISSUES:

Issue I: Whether under 35 U.S.C. § 102(e) claims 1-4 are anticipated by U.S. Patent No. 6,119,106 issued to Mersky et al. (hereinafter "Mersky"). Paragraphs 1 and 2 of the final Office Action, mailed February 7, 2002, describe the Examiner's current position on this issue.

Issue II: Whether under 35 U.S.C. § 103(a) claims 5-22 are unpatentable over Mersky in view of U.S. Patent No. 6,012,045 issued to Barzilai et al. (hereinafter "Barzilai"). The Examiner's position on this rejection is detailed in paragraphs 3 and 4 of the final Office Action mailed on February 7, 2002.

GROUPING OF THE CLAIMS:

Appellant submits that the claims do not stand or fall together for the reasons set forth in the Argument section. For the purposes of this appeal, the claims are grouped as follows:

- Group I: Claims 1, 3 and 26 stand or fall together.
- Group II: Claims 5, 6 and 8 stand or fall together.
- Group III: Claims 11-13, and 15 stand or fall together.
- Group IV: Claims 16 and 18 stand or fall together.
- Group V: Independent claim 19 stands alone.
- Group VI: Claims 20 and 21 stand or fall together.
- Group VII: Claims 22-24 stand or fall together.
- Group VIII: Dependent claims 2, 7, 14 and 17 stand or fall together.

Group IX: Dependent claims 4 and 9 stand or fall together.

Group X: Dependent claim 10 stands alone.

Group XI: Dependent claim 25 stands alone.

Although certain claims are grouped above to stand or fall together, Appellant reserves the right outside the context of this appeal to argue independent patentability of any grouped claims.

ARGUMENT

I. Issue I, Group I: Anticipation Rejection of Claims 1, 3 and 26

Claims 1, 3 and presumably claim 26 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,119,106 to Mersky et al. (hereinafter “Mersky”). Claim 26 was entered in the Advisory Action, but no reasons for its rejection were given in the Advisory Action. For the purposes of this appeal, we presume that the anticipation rejection of claims 1-4 is extended to claim 26. However, clarification is requested on the rejection of Claim 26.

For this rejection to be proper, Mersky “must teach or suggest each aspect of the claimed invention either explicitly or impliedly. See MPEP, Original Eighth Edition, August, 2001, §706.02. Appellants respectfully disagree with the rejection based upon Mersky as several limitations of Claim 1 are not taught or suggested by Mersky. More specifically, Mersky fails to teach or suggest: (1) “contacting the money order system *via the internet* by a user,” (2) “transmitting information to the money order system *via the internet* to purchase said money

order,” and (3) “sending said generated money order to said intended receiver.” For at least these reasons, Appellant appeals the rejection of claims 1, 3 and 26.

Mersky (see col. 3, lines 25-34, or col. 11, lines 15-32) teaches that their invention could be used to purchase money orders “*at an agent site*” 10. See Mersky, col. 11, line 21. The agent system 4 further includes a peripheral printer or other device to generate the money order. See Id., col. 11, lines 23-25. The agent system 4 processes the purchases and transmits information to the host system 6. See Id., col. 11, lines 26-27. Reports are sent by the host system 6 to the money order company (not shown in the figures). See Id., col. 11, lines 27-30. The service provider or host system 6 pays the money order and receives payment from any of the agent systems 4. See Id., col. 11, lines 30-32.

The ability to buy a money order from an agent store where it is printed locally described in Mersky is largely described in the background section of the present application. See Present Application, page 2, lines 12-13. This is the conventional processes where a user visits a physical store, in-person, to purchase a money order that is printed locally and given to the user. Banks, the postal service, convenience stores, grocery stores and other retail locations typically offer this service.

The claimed invention is appreciably distinct from Mersky and the conventional systems. With the invention of claim 1, there is no need to visit a physical store and no need to address and stamp an envelope to send the money order to the intended receiver—clear advantages over Mersky that have eased payments, especially, payments for auction goods.

For the following reasons, Mersky does not teach or suggest limitations required by the invention of claim 1. First, the claimed invention requires “contacting the money order

system *via the internet* by a user”, whereas Mersky teaches a user visiting a physical agent site 10 (Mersky, col. 5, line 38) to get the money order. Second, the claimed invention requires “transmitting information to the money order system *via the internet* to purchase said money order,” whereas no information passes over the internet in Mersky as part of the purchase of the money order. The agent system 4 of Mersky dials into the host system 6 once a day through a direct circuit switched telephone connection to report transaction information (Mersky, col. 9, lines 37-43), but does not teach the user connecting with the internet as is required in the claims. The user, the agent taking the information and the printer are co-located in Mersky such that there is no need to transport information over the internet during the purchase process. See Mersky, col. 11, lines 21-32. Finally, the claimed invention requires “sending said generated money order to said intended receiver,” but Mersky does not teach sending the money order and only teaches printing it for the user at the agent site. Id.

For at least the forgoing reasons, the anticipation rejection of claims 1, 3 and 26 is believed improper.

II. Issue II, Group II: Obviousness Rejection of Claims 5, 6 and 8

Claims 5, 6 and 8 are rejected under 35 U.S.C. §103(a) as being unpatentable over Mersky in view of Barzilai et al. (hereinafter “Barzilai”). Appellants believe a *prima facie* case of obviousness has not been properly set forth by the Examiner with regard to this rejection. The Examiner is charged with putting forth a *prima facie* showing of obviousness. The basic test is excerpted below:

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim

limitations.” See MPEP, Original Eighth Edition, August, 2001, §2143.

Appellants believe the preceding test for a *prima facie* case of obviousness has not been set forth by the Examiner. To wit, Mersky and Barzilai do not teach or suggest limitations in the claims; even if they did teach all limitations, there is no motivation to combine these references; and there could be no reasonable expectation of success given express teaching away found in Mersky. With regard to claims 5, 6 and 8, neither Mersky nor Barzilai teach or suggest: (1) the buyer contacting a money order system internet site with the internet; (2) the buyer transmitting information to the money order system via the internet; (3) that the information includes an identification of the seller; or (4) delivering the money order from the money order system to the seller.

The final Office Action relies upon Mersky to teach the preceding limitations. See final Office Action, page 4, paragraph 4. As described in Argument Section I, Mersky cannot be relied upon to teach limitations relating to the remote purchase and delivery of a money order by a user. With regard to limitations (1) and (2) in the preceding paragraph, Mersky teaches the user visiting the money order system or agent location 4 in-person (see Mersky, col. 5, lines 37-39) and not over the internet as required by the claims. Limitation (3) is not taught in Mersky either. With regard to limitation (4), Mersky teaches the buyer going to the agent location 4 in person (Id.) and that the money order is printed at the agent location 4. See

Id., col. 11, lines 24-25. Presumably, this money order is given to the buyer but Mersky is silent on this point. Certainly, there is no teaching of delivering the money order to the seller as required in the claims. Barzilai is apparently relied upon to teach everything related to online auctions (see final Office Action, page 5, first two paragraphs), but not the money order related limitations such that the above four limitations are taught in Barzilai. Even if Mersky is combined with Barzilai, these references do not teach or suggest the aforementioned limitations of the claims.

The obviousness rejection also lacks a proper showing of a motivation to combine Mersky with Barzilai. The Appellant believes a combination of Mersky and Barzilai would not occur to one of ordinary skill in the art at the time the invention was made without the benefit of impermissible hindsight reconstruction gleaned from the patent application. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the reference suggests the desirability of such a modification. See In re Fritch 28 USPQ2d 1780 (Fed. Cir. 1992), see also In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984). “It is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.” Id.

As best understood by the Appellant, the final Office Action concludes that it is proper to combine the teachings, but apparently relies upon official notice to combine these references. See final Office Action, page 7, last paragraph. This official notice does not address the express teaching away in Mersky pointed out in the earlier response. See Response to First Office Action, last paragraph on page 7 through page 8. If official notice is being proposed and maintained for the proposition that it is well known that Mersky could be combined with

Barzilai, Appellants respectfully traverse this official notice once again and hereby reiterate our request an express showing of documentary proof of this proposition as set forth in MPEP 2144.03. Further, the Appellants request specific addressing of why the express teach away in Mersky can be overcome by this official notice. See MPEP, Original Eighth Edition, August, 2001, §2141.02 for a discussion of teaching away.

As stated in the previously filed responses, Mersky teaches away from online payment by a user by arguing that systems relying upon computers or other devices for electronic funds transfer are unavailing for customers who do not have either a computer or other communication device, or a checking account or other bank account. See Mersky, col. 1, lines 55-58. Mersky further explains that such systems do not accommodate customers that desire, or are only able, to pay creditors with cash. See Id., col. 1, lines 58-63. Teaching that computers and electronic transfers are one of the problems with the prior art, makes Mersky ill-suited for combination with other references for an obviousness rejection. More specifically, there could be no reasonable expectation of success where Mersky teaches away from any combination.

For at least the forgoing reasons, Appellant requests reconsideration the combination of Mersky and Barzilai in any obviousness rejection of claims 5, 6 and 8.

III. Issue II, Group III: Obviousness Rejection of Claims 11-13 and 15

Claims 11-13 and 15 are rejected under 35 U.S.C. §103(a) as being unpatentable over Mersky in view of Barzilai. As described in Argument Section I, Mersky cannot be relied upon to teach limitations relating to the remote purchase of a money order by a user. Further, the Appellant reiterates the position of Argument Section II that the obviousness rejection lacks a proper showing of a motivation to combine Mersky with Barzilai. As also presented in

Argument Section II, there could be no reasonable expectation of success in combining Mersky with Barzilai given express teaching away found in Mersky. The motivation to combine and reasonable expectation of success arguments are the same as in Argument Section II and are not repeated here for the sake of brevity.

Even if Mersky is combined with Barzilai, these references do not teach or suggest all limitations of the claims. With regard to claims 11-13 and 15, neither Mersky nor Barzilai teach or suggest: (1) “a money order sub-system that is accessed via said web site upon selection by the bidder of said money order request selection,” or (2) “confirming to the bidder that the money order request has been fulfilled.” Mersky teaches the user visiting the money order system or agent location 4 in-person (see Mersky, col. 5, lines 37-39) and not over the via a web site as required by the claims. Further, there is no teaching in Mersky confirming that a money order request has been fulfilled. Barzilai does not teach confirming that the money order request is being fulfilled either.

For at least the forgoing reasons, Appellant requests reconsideration the combination of Mersky and Barzilai in any obviousness rejection of claims 11-13 and 15.

IV. Issue II, Group IV: Obviousness Rejection of Claims 16 and 18

Claims 16 and 18 are rejected under 35 U.S.C. §103(a) as being unpatentable over Mersky in view of Barzilai. As described in Argument Section I, Mersky cannot be relied upon to teach limitations relating to the remote purchase of a money order by a user. Further, the Appellant reiterates the position of Argument Section II that the obviousness rejection lacks a proper showing of a motivation to combine Mersky with Barzilai. As also presented in

Argument Section II, there could be no reasonable expectation of success in combining Mersky with Barzilai given express teaching away found in Mersky. The motivation to combine and reasonable expectation of success arguments are the same as in Argument Section II and are not repeated here for the sake of brevity.

Even if Mersky is combined with Barzilai, these references do not teach or suggest all limitations of the claims. With regard to claims 16 and 18, neither Mersky nor Barzilai teach or suggest: (1) “a processor . . . programmed to request funds for a money order transaction upon receipt of a money order request,” or (2) “a processor . . . programmed to upon confirmation of receipt of the requested funds, instruct the money order dispensing apparatus to generate a money order.” Mersky teaches that funds are cleared by once-a-day communication between the agent location 4 and the host system 6 (see Mersky, col. 9, lines 37-44) such that funds are not requested upon receipt of a money order request. With regard to limitation (2), Mersky is silent on the conditions needed before a money order is generated. Barzilai does not teach money order related technology.

For at least the forgoing reasons, Appellant requests reconsideration the combination of Mersky and Barzilai in any obviousness rejection of claims 16 and 18.

V. Issue II, Group V: Obviousness Rejection of Claim 19

Claim 19 is rejected under 35 U.S.C. §103(a) as being unpatentable over Mersky in view of Barzilai. As described in Argument Section I, Mersky cannot be relied upon to teach limitations relating to the remote purchase of a money order by a user. Further, the Appellant reiterates the position of Argument Section II that the obviousness rejection lacks a proper

showing of a motivation to combine Mersky with Barzilai. As also presented in Argument Section II, there could be no reasonable expectation of success in combining Mersky with Barzilai given express teaching away found in Mersky. The motivation to combine and reasonable expectation of success arguments are the same as in Argument Section II and are not repeated here for the sake of brevity.

Even if Mersky is combined with Barzilai, these references do not teach or suggest all limitations of the claim. With regard to claim 19, neither Mersky nor Barzilai teach or suggest: (1) “data . . . based on a money order generation request from a requestor,” or (2) “data on a confirmation, for the requestor, of the money order authorization.” Mersky teaches an operator or agent to interact with the entry screen 15 rather than the customer directly interacting with the entry screen 15 such that limitation (1) is not taught. See Mersky, col. 7, lines 40-50. With regard to limitation (2), Mersky is silent on whether a money order request is confirmed. Barzilai does not teach money order related technology.

For at least the forgoing reasons, Appellant requests reconsideration the combination of Mersky and Barzilai in any obviousness rejection of claim 19.

VI. Issue II, Group VI: Obviousness Rejection of Claims 20 and 21

Claims 20 and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Mersky in view of Barzilai. As described in Argument Section I, Mersky cannot be relied upon to teach limitations relating to the remote purchase of a money order by a user. Further, the Appellant reiterates the position of Argument Section II that the obviousness rejection lacks a proper showing of a motivation to combine Mersky with Barzilai. As also presented in Argument Section II, there could be no reasonable expectation of success in combining Mersky

with Barzilai given express teaching away found in Mersky. The motivation to combine and reasonable expectation of success arguments are the same as in Argument Section II and are not repeated here for the sake of brevity.

Even if Mersky is combined with Barzilai, these references do not teach or suggest all limitations of the claims. With regard to claims 20 and 21, neither Mersky nor Barzilai teach or suggest: (1) “submitting . . . via a wide area network, a request for a money order,” or (2) “receiving confirmation, via the wide area network, that the money order request has been fulfilled.” With regard to limitation (1), Mersky teaches the user visiting the money order system or agent location 4 in-person to request a money order (see Mersky, col. 5, lines 37-39) and not requesting over a wide area network as required by the claim. With regard to limitation (2), Mersky is silent on whether a money order request is confirmed. Barzilai does not teach money order related technology.

For at least the forgoing reasons, Appellant requests reconsideration the combination of Mersky and Barzilai in any obviousness rejection of claims 20 and 21.

VII. Issue II, Group VII: Obviousness Rejection of Claims 22-24

Claims 22-24 are rejected under 35 U.S.C. §103(a) as being unpatentable over Mersky in view of Barzilai. As described in Argument Section I, Mersky cannot be relied upon to teach limitations relating to the remote purchase of a money order by a user. Further, the Appellant reiterates the position of Argument Section II that the obviousness rejection lacks a proper showing of a motivation to combine Mersky with Barzilai. As also presented in Argument Section II, there could be no reasonable expectation of success in combining Mersky with Barzilai given express teaching away found in Mersky. The motivation to combine and

reasonable expectation of success arguments are the same as in Argument Section II and are not repeated here for the sake of brevity.

Even if Mersky is combined with Barzilai, these references do not teach or suggest all limitations of the claims. With regard to claims 22-24, neither Mersky nor Barzilai teach or suggest: (1) “receiving . . . via a wide area network, a money order request,” (2) “requesting an electronic funds transfer upon receipt of the money order request,” or (3) “to generate a money order upon receipt of the funds.” With regard to limitation (1), Mersky teaches the user visiting the money order system or agent location 4 in-person to request a money order (see Mersky, col. 5, lines 37-39) and not requesting over a wide area network as required by the claim. Mersky teaches that funds are cleared by once-a-day communication between the agent location 4 and the host system 6 (see Mersky, col. 9, lines 37-44) such that funds are not requested upon receipt of a money order request as in limitation (2). With regard to limitation (3), Mersky is silent on the conditions needed before a money order is generated. Barzilai does not teach money order related technology.

For at least the forgoing reasons, Appellant requests reconsideration the combination of Mersky and Barzilai in any obviousness rejection of claims 22-24.

VIII. Issues I and II, Group VIII: Novelty/Obviousness Rejection of Claims 2, 7, 14, and 17

Dependent claims 2 and 7, 14, and 17 are believed by the Appellant to be separately patentable from their independent parent claims because they generate a message that the money order has been sent, authorized or fulfilled. Claim 2 is rejected under 35 U.S.C. §102(e) as being anticipated by Mersky, and Claims 7, 14 and 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over Mersky in view of Barzilai. To simplify this discussion, I

will discuss how claims 2, 7, 14 and 17 are patentable over a combination of Mersky in view of Barzilai.

As described in Argument Section I, Mersky cannot be relied upon to teach limitations relating to the remote purchase of a money order by a user of the claims. Further, the Appellant reiterates the position of Argument Section II that the obviousness rejection lacks a proper showing of a motivation to combine Mersky with Barzilai. As also presented in Argument Section II, there could be no reasonable expectation of success in combining Mersky with Barzilai given express teaching away found in Mersky. The motivation to combine and reasonable expectation of success arguments are the same as in Argument Section II and are not repeated here for the sake of brevity.

Even if Mersky is combined with Barzilai, these references do not teach or suggest all limitations of the claims. With regard to claims 2 and 7, 14, and 17, neither Mersky nor Barzilai teach or suggest generating a message that the money order has been sent. Mersky is silent on what is done after a money order is generated. Barzilai does not teach money order related technology.

For at least the forgoing reasons, Appellant requests reconsideration anticipation rejection of claim 2 in view of Mersky and the obviousness rejection of claim 7, 14, and 17 in view of Mersky and Barzilai.

IX. Issues I and II, Group IX: Anticipation/Obviousness Rejection of Claims 4 and 9

Claims 4 and 9 are believed by the Appellant to be separately patentable from their independent parent claims because a funds account is created in the money order system for the user that has a predetermined amount of money. That account is debited for to purchase the

money order. Claim 4 is rejected under 35 U.S.C. §102(e) as being anticipated by Mersky, and Claim 9 is rejected under 35 U.S.C. §103(a) as being unpatentable over Mersky in view of Barzilai. To simplify this discussion, I will discuss how both claims 4 and 9 are patentable over a combination of Mersky in view of Barzilai.

As described in Argument Section I, Mersky cannot be relied upon to teach limitations relating to the remote purchase of a money order by a user of the claims. Further, the Appellant reiterates the position of Argument Section II that the obviousness rejection lacks a proper showing of a motivation to combine Mersky with Barzilai. As also presented in Argument Section II, there could be no reasonable expectation of success in combining Mersky with Barzilai given express teaching away found in Mersky. The motivation to combine and reasonable expectation of success arguments are the same as in Argument Section II and are not repeated here for the sake of brevity.

Even if Mersky is combined with Barzilai, these references do not teach or suggest all limitations of the claims. With regard to claims 4 and 9, neither Mersky nor Barzilai teach or suggest: (1) a funds account is created in the money order system for the user that has a predetermined amount of money, or (2) that the account is debited for to purchase the money order. Mersky clears accumulated transactions once a day and does not teach storing a value in the manner of limitation (1). See Mersky, col. 9, lines 33-43. Further, Mersky has no account to debit because transactions are just cleared at the end of the day. Barzilai does not teach money order related technology.

For at least the forgoing reasons, Appellant requests reconsideration anticipation rejection of claim 4 in view of Mersky and the obviousness rejection of claim 9 in view of Mersky and Barzilai.

X. Issue II, Group X: Obviousness Rejection of Claim 10

Claim 10 is believed by the Appellant to be separately patentable from the independent parent claim because of the limitation related to shipping the goods after the money order is sent, but before the money order is received. As described in Argument Section I, Mersky cannot be relied upon to teach limitations relating to the remote purchase of a money order by a user of the claims. Further, the Appellant reiterates the position of Argument Section II that the obviousness rejection lacks a proper showing of a motivation to combine Mersky with Barzilai. As also presented in Argument Section II, there could be no reasonable expectation of success in combining Mersky with Barzilai given express teaching away found in Mersky. The motivation to combine and reasonable expectation of success arguments are the same as in Argument Section II and are not repeated here for the sake of brevity.

Even if Mersky is combined with Barzilai, these references do not teach or suggest all limitations of the claim. With regard to claim 10, neither Mersky nor Barzilai teach or suggest: shipping the goods after the money order is sent, but before the money order is received. Mersky and Barzilai do not teach or suggest this limitation.

For at least the forgoing reasons, Appellant requests reconsideration the combination of Mersky and Barzilai in any obviousness rejection of claim 10.

XI. Issue II, Group XI: Obviousness Rejection of Claim 25

Claim 25 is believed by the Appellant to be separately patentable from the independent parent claim because it transmits the money order to a party. As described in Argument Section I, Mersky cannot be relied upon to teach limitations relating to the remote purchase of a money order by a user of the claims. Further, the Appellant reiterates the position of Argument Section II that the obviousness rejection lacks a proper showing of a motivation to combine Mersky with Barzilai. As also presented in Argument Section II, there could be no reasonable expectation of success in combining Mersky with Barzilai given express teaching away found in Mersky. The motivation to combine and reasonable expectation of success arguments are the same as in Argument Section II and are not repeated here for the sake of brevity.

Even if Mersky is combined with Barzilai, these references do not teach or suggest all limitations of the claim. With regard to claim 25, neither Mersky nor Barzilai teach or suggest: transmitting the money order to a party. In Mersky, the agent system 4 further includes a peripheral printer or other device to generate the money order. See Mersky, col. 11, lines 23-25. Mersky is silent on what is done after printing. Barzilai does not teach money order related technology.

For at least the forgoing reasons, Appellant requests reconsideration the combination of Mersky and Barzilai in any obviousness rejection of claim 25.

CONCLUSION:

Appellant believes that the above discussion is fully responsive to all grounds of rejection set forth in the final Office Action dated February 7, 2002 and the Advisory Action

dated May 13, 2002. Please deduct the requisite fee, pursuant to 37 C.F.R. §1.17(c), of \$320.00 from deposit account 20-1430 and any additional fees associated that may be due in association with the filing of this Brief. This Brief is submitted in triplicate.

If for any reason the Examiner believes a telephone conference would in any way expedite resolution of the issues raised in this appeal, the Examiner is invited to telephone the undersigned attorney at (303) 571-4000.

Respectfully submitted,

TOWNSEND and TOWNSEND and CREW LLP

Date: August 7, 2002

By



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APPENDIX LIST OF PENDING CLAIMS

1. (As Filed) A method of purchasing a money order via the internet, comprising the steps of:

providing a money order system capable of generating money orders;

contacting the money order system via the internet by a user desiring to purchase a money order in a predefined amount;

transmitting information to the money order system via the internet required to purchase said money order, said information including at least a user's identification, an identification of an intended receiver of the money order and an financial amount for the money order;

generating a money order from said money order system upon receipt of said transmitted information; and

sending said generated money order to said intended receiver.

2. (As Filed) A method of purchasing a money order via the internet as recited in claim 1 further including the step of generating an e-mail message to at least one of said user or intended receiver of said money order that said money order has been sent to said intended receiver.

3. (As Filed) A method of purchasing a money order via the internet as recited in claim 2 further including the steps of:

transmitting credit card information associated with said user; and

electronically processing said credit card information to make available funds needed for said purchase of said money order by said user.

4. (As Filed) A method for purchasing a money order via the internet as recited in claim 2 further including the steps of:

establishing a funds account on said users behalf in said money order system, said funds account having a predetermined amount of monetary funds;

electronically deducting a predetermined amount of funds from said funds account in accordance with the amount of funds required to generate said users purchased money order.

5. (As Filed) A method of purchasing a money order from a money order system via the internet for the purchase of goods purchased from an internet-based auction transaction, the method including the steps of:

awarding a bid to a buyer for goods to be purchased from a seller from an auction process conducted between said buyer and seller via the internet on an internet auction site;

contacting said an internet site for said money order system via the internet by said buyer after said bid is awarded to said buyer;

transmitting information to said money order system via the internet by said buyer to purchase said money order for said sale of said goods, said information including at least said buyers identification, an identification of said seller and a financial amount for the money order;

generating a money order from said money order system upon receipt of said transmitted information from said buyer;

delivering from money order system said generated money order to said seller;
and

delivering said goods from said seller to buyer after said money order is generated.

6. (As Filed) A method as recited in claim 5 further including the step of providing a hyper-link in the auction site to the money order system site.

7. (As Filed) A method as recited in claim 6 further including the step of generating a message to at least one of said buyer or seller stating that said money order has been sent to said seller.

8. (As Filed) A method as recited in claim 7 further including the steps of:
transmitting credit card information associated with said buyer to said money

order system internet site; and

electronically processing said credit card information to make available funds needed for said purchase of said money order by said buyer in said money order system site.

9. (As Filed) A method as recited in claim 7 further including the steps of:
establishing a funds account on said buyers behalf in said money order system, said funds account having a predetermined amount of monetary funds;
electronically deducting a predetermined amount of funds from said funds account in accordance with the amount of funds required to generate said money order generated for the buyer.

10. (As Filed) A method as recited in claim 7 further including the step of shipping the goods from said seller to buyer prior to said sellers receipt of said money order and after said information is transmitted from said money order system to said seller indicating that said money order is being delivered to said seller.

11. (As Added) A system comprising:
a server configured to conduct an internet-based auction via a web site, said server further configured to cause to be displayed, via said web site, a money order request selection selectable by a bidder that participated in an auction conducted via said web site; and
a money order sub-system that is accessed via said web site upon selection by the bidder of said money order request selection, said money order sub-system configured for processing a money order request, said processing comprising:
requesting funds for a money order transaction upon receipt of a money order request;
upon confirmation of receipt of the requested funds, instructing a money order dispensing apparatus to generate a money order; and
confirming to the bidder that the money order request has been fulfilled.

12. (As Added) A system according to Claim 11 wherein said money order sub-

system comprises a money order server configured to communicate with said auction server, and a processor, said money order server coupled to said processor.

13. (As Added) A system according to Claim 12 wherein said processor is programmed to request funds for a money order transaction upon receipt of a money order request by transmitting credit card information to a billing server.

14. (As Added) A system according to Claim 12 wherein said money order server is further configured to communicate with a seller to confirm that a money order has been authorized.

15. (As Added) A system according to Claim 12 wherein said money order sub-system further comprises a database coupled to said processor, said database comprising data for submitting an electronic funds transfer request and data for money order authorizations.

16. (As Added) A money order system for processing a money order request, the money order system configured to communicate with a money order dispensing apparatus, said money order system comprising:

a server for receiving communications from and transmitting communications to a money order requestor;

a memory for storing information relating to money order transactions;

a processor coupled to said server and to said memory, said processor programmed to:

request funds for a money order transaction upon receipt of a money order request;

upon confirmation of receipt of the requested funds, instruct the money order dispensing apparatus to generate a money order.

17. (As Added) A system according to Claim 16 wherein said processor is further programmed to confirm to the requestor that the money order request has been fulfilled.

18. (As Added) A system according to Claim 16 wherein said memory comprises a database, said database comprising data for submitting an electronic funds transfer request and data for money order authorizations.

19. (As Added) A database, comprising:
data for submitting an electronic funds transfer request and based on a money order generation request from a requestor;
data on a completed electronic funds transfer;
data on authorization of generation of a money order; and
data on a confirmation, for the requestor, of the money order authorization.

20. (As Added) A method for purchasing a money order utilizing a money order system, said method comprising:
submitting, to the money order system and via a wide area network, a request for a money order, the request including authorization to debit an account; and
receiving confirmation, via the wide area network, that the money order request has been fulfilled.

21. (As Added) A method according to Claim 20 wherein submitting a request for a money order comprises the steps of:
selecting a money order request selection on a web page;
entering data requesting the money order including information identifying an account to be debited; and
authorizing debiting the account.

22. (As Added) A method for generating a money order from a money order dispensing apparatus, said method comprising:
receiving, from a requestor and via a wide area network, a money order request;
requesting an electronic funds transfer upon receipt of the money order request;

and

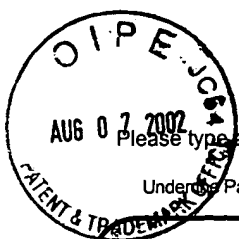
instructing the money order dispensing apparatus to generate a money order upon receipt of the funds in response to the electronic funds transfer request.

23. (As Added) A method according to Claim 22 wherein requesting an electronic funds transfer comprises transmitting credit card information to a billing server.

24. (As Added) A method according to Claim 22 further comprising the step of notifying a party that is to receive the money order that the money order has been authorized.

25. (As Added) A method according to Claim 22 further comprising the step of transmitting the money order to a party.

26. (As Added) A method of purchasing a money order via the internet as recited in claim 1, wherein the sending step is initiated by the money order system.



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PTO/SB/21 (08-00)

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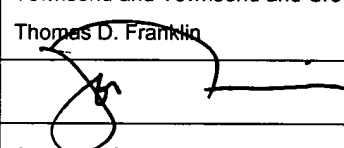
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TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>	Application Number	09/307,485	
	Filing Date	May 10, 1999	
	First Named Inventor	Stephen Chin	
	Group Art Unit	Pwu, Jeffrey C.	
	Examiner Name	3624	
Total Number of Pages in This Submission	28	Attorney Docket Number	020375-002900US

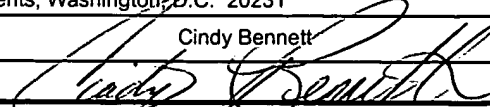
ENCLOSURES (check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Response <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application) <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition Routing Slip (PTO/SB/69) and Accompanying Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s)	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Return Postcard
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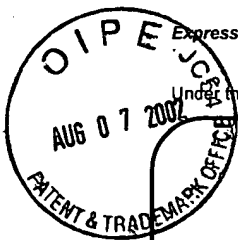
GROUP 3600

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT		
Firm and Individual name	Townsend and Townsend and Crew LLP Thomas D. Franklin	
Signature		
Date	August 7, 2002	

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PTO/SB/17 (11-01)

App. for use through 10/31/2002. OMB 0651-0032

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**FEE TRANSMITTAL
for FY 2002**

Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27**TOTAL AMOUNT OF PAYMENT** (\$) **320**

Complete if Known

Application Number 09/307,485

Filing Date May 10, 1999

First Named Inventor Stephen Chin

Examiner Name Pwu, Jeffrey C.

Group Art Unit 3624

Attorney Docket No. 020375-002900US

METHOD OF PAYMENT (check all that apply)☐ Check ☐ Credit Card ☐ MoneyOrder ☐ Other ☐ None☒ Deposit Account:Deposit
Account
Number

20-1430

Deposit
Account
NameTownsend and Townsend and
Crew LLP

The Commissioner is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☐ Credit any overpayments☒ Charge any additional fee(s) during the pendency of this application☐ Charge fee(s) indicated below, except for the filing fee
to the above-identified deposit account.**FEE CALCULATION****1. BASIC FILING FEE**

Large Entity Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description
101	740	201	370	Utility filing fee
106	330	206	165	Design filing fee
107	510	207	255	Plant filing fee
108	740	208	370	Reissue filing fee
114	160	214	80	Provisional filing fee

Fee Paid

SUBTOTAL (1)

(\$)

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

			Extra Claims	Fee from below	Fee Paid
Total Claims		-20**	=		
Independent Claims		-3**	=		
Multiple Dependent					

Large Entity Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description
103	18	203	9	Claims in excess of 20
102	84	202	42	Independent claims in excess of 3
104	280	204	140	Multiple dependent claim, if not paid
109	84	209	42	** Reissue independent claims over original patent
110	18	210	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2)

(\$)

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)**3. ADDITIONAL FEES**

Large Entity Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid
105	130	205	65	Surcharge - late filing fee or oath	
127	50	227	25	Surcharge - late provisional filing fee or cover sheet.	
139	130	139	130	Non-English specification	
147	2,520	147	2,520	For filing a request for reexamination	
112	920*	112	920*	Requesting publication of SIR prior to Examiner action	
113	1,840*	113	1,840*	Requesting publication of SIR after Examiner action	
115	110	215	55	Extension for reply within first month	
116	400	216	200	Extension for reply within second month	
117	920	217	460	Extension for reply within third month	
118	1,440	218	720	Extension for reply within fourth month	
128	1,960	228	980	Extension for reply within fifth month	
119	320	219	160	Notice of Appeal	
120	320	220	160	Filing a brief in support of an appeal	320
121	280	221	140	Request for oral hearing	
138	1,510	138	1,510	Petition to institute a public use proceeding	
140	110	240	55	Petition to revive - unavoidable	
141	1,280	241	640	Petition to revive - unintentional	
142	1,280	242	640	Utility issue fee (or reissue)	
143	460	243	230	Design issue fee	
144	620	244	310	Plant issue fee	
122	130	122	130	Petitions to the Commissioner	
123	50	123	50	Petitions related to provisional applications	
126	180	126	180	Submission of Information Disclosure Stmt	
581	40	581	40	Recording each patent assignment per property (times number of properties)	
146	740	246	370	Filing a submission after final rejection (37 CFR § 1.129(a))	
149	740	249	370	For each additional invention to be examined (37 CFR § 1.129(b))	
179	740	279	370	Request for Continued Examination (RCE)	
169	900	169	900	Request for expedited examination of a design application	

Other fee (specify) _____

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3)

(\$) 320

SUBMITTED BY

Complete (if applicable)

Name (Print/Type)

Thomas D. Franklin

Registration No. (Attorney/Agent)

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Telephone

303-571-4000

Signature

Date

8/7/02

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